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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,076	07/21/2003	Vladimir Mancevski	500929.000017B	5156
27644	7590	06/09/2008	EXAMINER	
THOMPSON & KNIGHT LLP, PATENT PROSECUTION DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1900 AUSTIN, TX 78701			MCCRACKEN, DANIEL	
ART UNIT	PAPER NUMBER	1793		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/624,076	<b>Applicant(s)</b> MANCEVSKI, VLADIMIR
	<b>Examiner</b> DANIEL C. MCCRACKEN	<b>Art Unit</b> 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 January 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 25-45 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 25-45 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/0256/06)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Citation to the Specification will be in the following format: (S. # : ¶/L) where # denotes the page number and ¶/L denotes the paragraph number or line number. Citation to patent literature will be in the form (Inventor # : LL) where # is the column number and LL is the line number. Citation to the pre-grant publication literature will be in the following format (Inventor # : ¶) where # denotes the page number and ¶ denotes the paragraph number.

#### *Response to Arguments*

Claims 10-24 were pending. Applicants have cancelled Claims 1 – 24 and added new Claims 25-45. As such, all rejections in the Non-final Office Action of 7/24/2007 are mooted by cancellation and are accordingly withdrawn.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to Claim 26, a “sharp” tip is not disclosed in the Specification of the instant application, nor was it disclosed in provisional application 60/102,159.

Arguments traversing the “new matter” rejections should be accompanied by pinpoint citations to the specification or provisional application, indicating where support can be found.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The reference teaches each and every limitation of the rejected claims. The pinpoint citations are in no way to be construed as limitations of the teachings of the reference, but rather illustrative of particular instances where the teachings may be found.

Claims 25-29, 32-40 and 42-45 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/38705 to Baldeschwieler, et al. (California Institute of Technology) in view of Iijima, et al., *Single-shell carbon nanotubes of 1-nm diameter of 1-nm diameter*, Nature 1993: 363: 603-605 (hereinafter “Iijima at \_\_”).<sup>1</sup>

With respect to Claims 25-29, Baldeschwieler discloses a device comprising a substrate, a protrusion, pore and carbon nanotube. *See generally* (Baldeschwieler “Figs 1-6”). Note also the passages at (Baldeschwieler 6: 1-18) (tip and substrate/“cantilever” of the same material, silicon), (Baldeschwieler 14:23 – 15:6), and (Baldeschwieler 30: 1-11) (discussing nanotubes). Figures 5-6 teach the “pore on the protrusion” limitation. As to the sharp/flat limitations of Claims 26-27, Baldeschwieler discloses sharpening. (Baldeschwieler 6: 11). By reciting nanotubes, Baldeschwieler reasonably suggests “flat” nanotubes. Note that Baldeschwieler

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<sup>1</sup> Multiple reference 35 U.S.C. 102 rejections are proper when extra references are cited to explain the meaning of a term or show a characteristic not disclosed in the reference is inherent. See MPEP 2131.01 *et seq.*

suggests the nanotubes as disclosed by Iijima and Bethune. *See* (Baldeschwieler 35: 12-14). Iijima recites terminated nanotubes which appear to be “flat.” (Iijima at 603, “Fig. 1b, caption”). As to Claims 32-40 and 42-43, Baldeschwieler discloses planar surfaces with the probe tip (i.e. nanotube) attached perpendicular to the substrate (i.e. “forming an angle”). *See* (Baldeschwieler, “Figs. 1B, 5-6”). To the extent Claims 32-40 and 42-43 repeat limitations discussed previously (related to substrates, protrusions, nanotubes, etc.), the preceding discussion is relied upon. Note with respect to Claims 38-39, Iijima discloses nanotubes within the claimed range. *See e.g.* (Iijima “Fig. 2”). Finally, with respect to Claims 44-45, these claims are being interpreted as requiring nothing more than Claim 25. Furthermore any surface – by nature of it being “a surface” - can be “adapted” for attachment to another.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The references cited teach each and every limitation of the rejected claims. The pinpoint citations are in no way to be construed as limitations of the teachings of the reference, but rather illustrative of particular instances where the teachings may be found.

Claims 25-29, 32-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/38705 to Baldeschwieler, et al. (California Institute of Technology) in view of Iijima, et al., *Single-shell carbon nanotubes of 1-nm diameter of 1-nm diameter*, Nature 1993: 363: 603-605.

The preceding discussion of Baldeschwieler accompanying the anticipation rejection *supra* is expressly incorporated herein by reference. With respect to Claims 26-27,

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notwithstanding the rejection as set forth in the anticipation rejection, to the extent Baldeschwieler and Iijima may not disclose the geometries claimed, Baldeschwieler provides a discussion of tip geometry its effect on image resolution. (Baldeschwieler 2: 15-23). Thus, utilizing a tapered (i.e. sharp) or flat tip is an obvious expedient to the skilled artisan, selection of the tip being based on the desired resolution of a particular surface. Finally, with respect to Claim 41, to the extent Baldeschwieler may not teach the aspect ratio (length/diameter), optimizing the length is for the end application (probe tip, field emitter, etc.) is an obvious expedient. There is nothing on the record to indicate that the present nanotubes differ from those of the prior art (see specification pgs. 14-16).

Claims 25-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/38705 to Baldeschwieler, et al. (California Institute of Technology) in view of Iijima, et al., *Single-shell carbon nanotubes of 1-nm diameter of 1-nm diameter*, Nature 1993: 363: 603-605 in view of Li, et al., *Large-Scale Synthesis of Aligned Carbon Nanotubes*, Science 1996; 274: 1701-1703 (hereinafter “Li at \_\_”).

The preceding discussion of Baldeschwieler accompanying the anticipation rejection *supra* is expressly incorporated herein by reference. With respect to Claims 30-31, to the extent Baldeschwieler may not disclose placing a catalyst in the pore, note the passage quoted below:

In order to maximize production quality and the resolution of the images obtained by the scanning probes there is still a need for scanning probe tips *having regular, predictable shapes*, smaller radii of curvature and greater angle of taper than currently available.

(Baldeschwieler 2:31 – 3:3) (emphasis added). Thus, Baldeschwieler suggests a motivation or desirability for regular, predictable tips, which – as noted elsewhere – can be carbon nanotubes. (Baldeschwieler 30: 7) (“nanotubes”). Li discloses carbon nanotubes grown from a catalyst particle (iron) deposited in pores. *See* (Li “entire document, Fig. 4”). Note that Li describes the ability to control the geometries of the carbon nanotubes via the *in situ* CVD technique. *See e.g.* (Li at 1703, col. 1). One would be motivated to utilize the pore/catalyst as taught by Li in the probe of Baldeschwieler for any number of reasons, for example the ability to grow uniform nanotubes. There is nothing on the record to indicate that the present nanotubes differ from those of the prior art (see specification pgs. 14-16).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

All amendments made in response to this Office Action must be accompanied by a pinpoint citation to the Specification (i.e. page and paragraph or line number) to indicate where Applicants are drawing their support.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL C. MCCRACKEN whose telephone number is (571)272-6537. The examiner can normally be reached on Monday through Friday, 9 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel C. McCracken/  
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